

## REMARKS

*Claim Rejections - 35 U.S.C. § 112, ¶ 1*

Claims 1-9 are rejected under 35 USC 112, ¶ 1 as containing subject matter not enabled by the disclosure. The rejection is respectfully traversed.

The Examiner states that the claims recite improvements to the shape of an optical window, whereas the specification is asserted to disclose a wheel comprising an optical window. Applicant notes that the specification expressly discloses an optical window disposed on either a wheel (specification, page 2, lines 28-34; page 3, lines 12-13; and Figs. 4-5) or a linear device (specification, page 3, lines 19-31; Fig. 6). A window is disclosed throughout the specification, and expressly discussed at page 3, line 32 to page 4, line 11.

*Claim Rejections - 35 USC § 103*

Claims 1-19 are rejected under 35 USC 103(a) as being unpatentable over Jones et al. (U.S. Patent No. 4,906,843) in view of *In re Dailey*, 149 U.S.P.Q. 47 (CCPA 1976). The rejection is respectfully traversed.

The Examiner appears to have reiterated the previous § 102(a) rejection, replacing "Applicant's Admitted Prior Art" with Jones '843. Regardless, the application of *Dailey* is improper in this instance. *In re Dailey* is deemed applicable when its facts are sufficiently similar to those of the present application:

*2144.04 Legal Precedent as Source of Supporting Rationale [R-1]*

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.... If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection. (MPEP 2144.04)

The facts of *Dailey* can be readily distinguished from the present application. The specification contains persuasive evidence that the particular configuration of the claimed optical window is significant. The specification discusses the shortcomings of a prior art "straight-sided windows" optical wheel. (Specification, page 2, lines 23-27 ("In the computer mouse example, this non-uniform light then passes through straight-sided apertures 22 in the signal-generating wheel 20 (FIG. 2)). The resultant waveform is not a square waveform shape, thereby introducing inaccuracy into the device and necessitating additional processing to correct for the waveform imperfection. (See specification, page 1, lines 23-29; page 2, lines 23-27.)

Applicant discloses the claimed "hourglass-shaped" optical window structure (page 2, line 29), the function and benefit of which is subsequently discussed at page 3, lines 1-11. The limitation of hourglass-shaped optical windows appears in all pending claims, including all independent claims. The structure of the claimed optical window is a specific limitation, the criticality of which has been demonstrated in the disclosure.


For the foregoing reasons, reconsideration and allowance of claims 1-19 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

#### CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-19 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Cliff D. Weston  
Reg. No. 48,307

MARGER JOHNSON & McCOLLOM, P.C.  
1030 SW Morrison Street  
Portland, OR 97205  
503-222-3613  
Customer No. 20575